

REMARKS

Re-examination and reconsideration of the subject application, in view of the remarks below, are respectfully requested.

Status of Claims

Claims 1 and 22-26 are pending in the application. Each of these claims is under consideration.

Claim Rejections – 35 U.S.C. § 112

Claims 1 and 22-26 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement with respect to the claim language “wherein the adhesive material is substantially free of polypropylene.” The rejection, however, lacks proper basis and should be withdrawn.

The Office Action states that the specification language Applicants pointed to and the Examples do not support the claim language. However, that’s not the case.

Initially, it should be noted that the subject matter of the claim need not be described literally in order to comply with the written description requirement. MPEP § 2163.02. All that is required is that the specification describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. MPEP § 2163. The examiner has the initial burden of proof, and compliance with the requirement is to be decided on a case-by-case basis. MPEP § 2163.04.

In this case, the Examiner has not fulfilled the burden because the Examiner merely addressed portions of Applicants’ specification individually without considering them together. The specification states that ethylene methyl acrylate copolymers have “advantages over polypropylene and the various polypropylene blends previously disclosed.” Page 2, lines 7-9. The examples in the specification all use adhesives that are free of polypropylene, albeit without explicitly mentioning it. Taken together, persons skilled in the art would readily recognize that Applicants were in possession of an adhesive composition that was free of polypropylene. This is especially true where,

as here, the inventors distinguish their invention, which uses ethylene methyl acrylate copolymers over the prior art products, which use polypropylene.

The Examiner's reliance on *Ex parte Grasselli* is also misplaced. Applicants are not merely relying on the absence of a positive recitation in the Examples, but are relying on that absence in combination with the specification's explicit distinction over the prior art use of polypropylene. Based on this combination of disclosure, it is reasonable for persons skilled in the art to conclude that Applicants were in possession of the currently claimed subject matter.

Accordingly, the rejection lacks proper basis and should be withdrawn.

Claim Rejections – 35 U.S.C. §§ 102/103

In the Office Action, claims 1 and 22-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(c) as being unpatentable over Peoples (U.S. Patent No. 4,508,771). For the following reasons, this rejection should be withdrawn.

At the outset, it should be noted that to the extent the rejection is based on 35 U.S.C. § 103(c), the rejection is improper because § 103(c) does not set forth a basis on which to deny a patent. On the contrary, it prohibits obviousness rejections based on prior art solely under § 102(e), (f), and (g) if the invention-in-question and the prior art are owned by the same assignee at the time the invention was made.

With respect to § 102(b), Peoples does not disclose or suggest each feature of claim 1. For example, as mentioned in the prior response, Peoples fails to disclose or suggest using an adhesive material comprising a blend of ethylene methyl acrylate copolymer and another polymer. Notwithstanding this difference, the Examiner still maintained the rejection, stating that "Peoples' thermoplastic backing [*sic*: barrier] layer may be applied directly to a tufted primary backing or may be applied over a pre-coat layer (col. 5, lines 12-34)." Perhaps the distinction was not stated precisely enough in the prior response. The specific distinction is that Peoples fails to disclose or suggest using an adhesive material comprising a blend of ethylene methyl acrylate copolymer and another polymer between the primary backing and the secondary backing.

Regardless of whether Peoples' barrier layer is applied directly onto the primary backing

or over a pre-coat layer, Peoples' barrier layer does not correspond to Applicants' adhesive material because it does not bind an upper surface of the secondary backing material to the bottom surface of the primary backing. In either case mentioned by the Examiner, the barrier layer is the secondary backing itself and not the adhesive material between the primary and secondary backings.

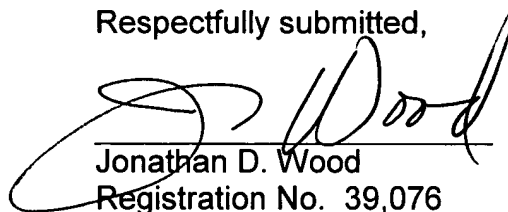
Accordingly, for the reasons set forth above, Peoples fails to disclose or suggest each feature of the present invention. As a result, there's no *prima facie* case of obviousness, much less one of anticipation. Therefore, the rejection under 35 U.S.C. §§ 102/103 should be withdrawn.

Conclusion

In summary, Applicants believe the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

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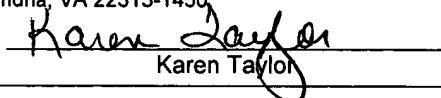
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Date

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Karen Taylor

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Date